

average skill in the art would be motivated by the references to prepare Applicant's compounds in the expectation that they would possess properties similar to the art compounds. The Examiner indicates that Applicant's arguments and the Petranyi Declaration Under Rule 132 have been carefully considered but are not deemed to be persuasive of patentability over the teachings of the prior art. The Examiner notes that mere differences in activity are not sufficient since unobviousness under 35 USC 103 requires unexpected properties not just an increase in a property that is expected. The Examiner also notes that, although the Hamberger references do not specifically disclose a compound within the scope of the present claims, this does not alter the fact that the artisan is placed in possession of the compounds and that the compounds would be expected to possess anticipated properties. The Examiner concludes that no invention is apparent in the presently claimed compounds and method-of-use over the teachings of the prior art. Applicant respectfully disagrees and traverses the rejection.

To facilitate prosecution of the instant Application, Applicant has limited the claims now in the Application to the three compounds of the Petranyi Declaration Under Rule 132. For this purpose, generic claim 15 has been replaced by new generic claim 24, which reads on the elected species of claim 10. The Examiner argues basically that Applicant's compounds would be expected to have antimycotic activity and that the increase in activity disclosed in Applicant's Declaration is not the unexpected properties required for

unobviousness. Applicant does not agree. The courts have long held that unexpected superiority in a property shared with prior art compounds is evidence which may rebut a prima facie case of obviousness based on structural similarities. (In re Chupp; 2USPQ 1437). The results in the Petranyi Declaration show that Applicant's claim 9 compound A is approximately 2 to 8 times more active than the Hamberger compound (i) against the strains numbered 158, 150, 167, 177 and 39; and that the claim 10 compound B is approximately 4 to 60 times more active than (i) against all strains tested except Candida albicans 124. Applicant's claim 23 compound C is approximately 4 to 16 times more active than the closest Hamberger compound (ii) against strains 158, 150, and 167. The Examiner indicates that a mere difference in activity between Applicant's compounds and the reference compounds is not persuasive of patentability. Applicant, however, does not believe that it can reasonably be said that 2 to 8, 4 to 60 and 4 to 16 times greater activity is a mere difference in activity. Increases of these magnitudes are clearly completely unexpected. Applicant submits that the Petranyi Declaration clearly rebuts any presumption of obviousness for the compounds of present claims 9, 10, 23 and new claim 24.

With regard to motivating one skilled in the art to prepare the instant compounds. Hamberger, as noted by the Examiner, does not clearly point to or exemplify any compounds which fall within the scope of the presently claimed invention. The European application reference

indicates on page 5, lines 21-23 (column 3, lines 55-57 of the U.S. patent), that the multiple bond is preferably at the remote terminal position of substituent R₆. In the present compounds, the alkynyl bond is in the α -position of R₆, that is, in the position adjacent to the point of substitution. The teachings of Hamberger, therefore, in addition to not clearly pointing to Applicant's compounds, would also lead away from them. It is only by picking and choosing from the broad language of the references, guided by the teachings of the instant application, that one is able to construct the presently claimed compounds. There is no way that the artisan using the Hamberger preferences and examples could take the references and combine them with his own knowledge and be in possession of any of Applicant's compounds. These compounds are clearly patentable over the Hamberger et al references; and therefore it is respectfully requested that the Examiner reconsider the instant rejection under 35 USC 103 and withdraw it.

The Examiner indicates that claims 9 and 23 now in the Application have been withdrawn from further consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected species. It is assumed that upon allowance of new generic claim 24, the withdrawn claims will be examined in accordance with MPEP 809.02 (a), (b), and (c).

In view of the above amendments and comments, it is believed that the instant Application is in condition for

allowance; and accordingly it is respectfully requested that the Examiner withdraw the rejection of the claims now in the Application and pass the Application to issue.

Respectfully submitted,

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